

REMARKS

Claims 1-17 were originally filed. In the previous Preliminary Amendment, Claims 18-20 were added. Claims 1-20 were the subject of the current Restriction Requirement. In the Amendment presented herein, Claims 21-38 are added. Claims 1-38 are now pending.

Amendments to the Specification and Abstract

The specification at page 29, line 1, is amended to correct an obvious error in chemical structure XVIII. Specifically, the substituent “i” on the phenyl group is corrected to read “R11.”

The Abstract is amended to correct a typographical error where the moiety “-S(O)_{0.2}R” is replaced by “-S(O)₀₋₂R.”

Amendments to the Claims

New Claims 21 to 26 are directed to compounds of formula VI. Support for new Claims 21 to 26 can be found throughout the specification as originally filed, for example, at page 6, line 11 to page 7, line 13; at page 23, line 7 to page 24, line 10; at pages 34 to 53 and in the Examples of the application as filed.

New Claim 27 is directed to a pharmaceutical composition comprising a compound as recited in new Claim 21. Support for new Claim 27 can be found throughout the specification as originally filed, for example, at page 71, line 1 to page 74, line 23.

New Claims 28 to 38 are directed to methods of treating cancer in a mammal comprising administering an effective amount of a compound as recited in new Claim 21. Support for new Claims 28 to 38 can be found throughout the specification as originally filed, for example, at page 65, line 22 to page 70, line 30 and in the Examples of the application as filed.

No new matter has been added by these amendments; therefore, examination is requested on the application as amended herewith.

Response to Restriction Requirement

In the current Restriction Requirement, the Examiner restricted the application and required an election of one of the following two groups under 35 U.S.C. § 121 and 372:

- Group I: Claims 1-12, 15, and 16 are drawn to methods of using compounds of formulae I-III, VI, VIII, and IX-XIII; and
- Group II: Claims 13, 14, and 17-20 are drawn to formulations, compositions and compounds of formulae I, VIII, and IX-XIII.¹

Of the claims added by the present amendment, new Claims 21-27 are drawn to formulations, compositions, and compounds and new Claims 28-38 are drawn to method of using formulations, compositions, and compounds. As such, Applicants believe new Claims 21-27 to be apart of Group II and new Claims 28-38 to be apart of Group I, as the groups are defined by the Examiner. Therefore, in an effort to be completely responsive, Applicants elect Group II in response to the current Restriction Requirement, which contains Claims 13, 14, and 17-20, as well as new Claims 21-27.

Applicants make this election with traverse and respectfully request that the Restriction Requirement be reconsidered. For a Restriction Requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); **and** (2) that the search and examination of the entire application cannot be made **without serious burden** on the Examiner. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner **must** examine it on the merits, even though it includes claims to distinct or independent inventions. (Emphasis added.)

Applicants respectfully submit that the Examiner has not shown that the second requirement has been met. Specifically, there has been no showing that it would be a serious burden to search and examine the two groups together.

¹ The text of the Restriction Requirement stated that Group II was “drawn **to uses of** formulations, compositions, and compounds” (emphasis added). However, the claims of Group II, namely Claims 13, 14, and 17-20, are drawn to formulations, compositions, and compounds, not uses thereof. Thus, the language in the current Restriction Requirement is believed to be a typographical error and Applicants proceed in this Response on that understanding.

For the reasons stated above, Applicants respectfully assert that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the Patent Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Examining all of the claims together would eliminate the necessity of prosecuting multiple, separate, yet intimately related applications. Thus, Applicants respectfully request that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Applicants also wish to remind the Examiner of the guidelines for rejoinder of claims as set forth in M.P.E.P. § 821.04, as they apply to the pending claims of the instant application.

Election of Species

The Examiner also required a species election. Specifically, the Examiner stated that in the event Applicants elected Group II (which they have), an election of various species must also be made. Specifically, the Examiner first required Applicants to either define each and every variable of the recited formulae such that a single disclosed compound is elected or elect a compound from those listed in Claim 18 (*i.e.*, Compounds 85-254).

Applicants elect “Compound 90” from the compounds listed in Claim 18. This election is made with traverse for the reasons presented above.

The Examiner also required an election of one or more specific anticancer agents. Applicants therefore elect “paclitaxel” as the specific anti-cancer agent. This election is also made with traverse for the reasons presented above. Furthermore, this requirement is believed to be in error in that none of the claims of Group II, which Applicants have elected herein, recite species of anti-cancer agents. Thus, it is unclear why the Examiner is requiring an election of anti-cancer agents for Group II. Solely in order to advance prosecution of the application are Applicants making an election of anti-cancer agents here, and since the claims of Group II do not recite any such specific species, this election is based on the specific anti-cancer agent from those described in the specification, for example, at page 70 of the application as filed.

In a likewise manner, Applicants elect the species “solid tumors” with traverse. While this election is not believed to be necessary at this point, Applicants make the election solely for the purposes of advancing prosecution.

Other Matters

Applicants also wish to address some discrepancies that occur in the text of the current Restriction Requirement. In particular, the mail date of the previously vacated Restriction Requirement is December 31, 2007, rather than November 1, 2007 as indicated at page 2, first paragraph, of the current Restriction Requirement.

Additionally, in the current Restriction Requirement at page 2 the Examiner stated that Forms 892 and 1449 had been previously communicated to Applicants. However, Forms 892 and 1449 were not part of the previously vacated Restriction Requirement. These forms were also not communicated to Applicants in any other Office Communication. Accordingly, Applicants respectfully request that the Examiner provide Forms 1449 and 892 in the next Office Action.

CONCLUSION

Applicants have elected with traverse Group II, which Claims 13, 14, and 17-27 are believed to read thereon. Also, Applicants have elected with traverse the species “Compound 90” and, to the extent needed, the anti-cancer agent paclitaxel and solid tumors as the type of cancer. **Claims 17-22 and 24-27 are believed to read on the group and species elected herein.**

Enclosed herewith is payment in the amount of \$785.00, which includes the \$230.00 for the fee under 37 C.F.R. § 1.17(a)(2) for a Two-Month Extension of Time and \$555.00 for the new claims (1 independent claim over those previously paid for at \$105.00 and 18 total claims over those previously paid for (18 x \$25.00) at \$450.00). No additional fees are believed due; however, the Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment to Deposit Account No. 14-0629.

ATTORNEY DOCKET NO.: 13198.0007U1
APPLICATION NO.: 10/579,149

Respectfully submitted,
NEEDLE & ROSENBERG, P.C.

/Christopher L. Curfman/

Christopher L. Curfman
Registration No. 52,787

NEEDLE & ROSENBERG, P.C.
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)

CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence – including any items indicated as attached, enclosed, or included – is being transmitted by EFS-WEB on the date indicated below.

/Christopher L. Curfman/

April 28, 2008

Christopher L. Curfman

Date